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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/058,291

01/30/2002

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IVGN 127.7 CON

3302

65482 7590 04/15/2008

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EXAMINER

GUZO, DAVID

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Election/Restriction

Applicants responded to the Non-Final rejection mailed 8/11/06 with an amended claim set (filed 2/13/07) comprising new claims reciting inventions not previously claimed or searched. The claims filed 2/13/07 comprise different inventions which are patentably distinct and are subject to restriction. A Restriction Requirement for the new claim set is communicated below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 113-124, drawn to a nucleic acid molecule comprising, in order: (a) an origin of replication, (b) a first positive selection marker, (c) a first promoter, (d) a first site-specific recombination site, (e) a coding sequence, (f) a second positive selection marker, (g) a second site specific recombination site, and (h) a second promoter; wherein the first promoter is operably linked to the coding sequence, wherein the second promoter is operably linked to the second positive selection marker, classified in class 536, subclass 23.1.
- II. Claims 125-138, drawn to a nucleic acid molecule comprising, in order: (a) a first site-specific recombination site, (b) a negative selection marker, (c) a positive selection marker, (d) a second site-specific recombination site, (e) a second positive selection marker; wherein the first positive selection marker and the second positive marker are different, classified in class 536, subclass 24.1.

- III. Claims 139-149, drawn to a nucleic acid molecule comprising, in order: (a) an origin of replication, (b) a first positive selection marker, (c) a first site-specific recombination site, (d) a second positive selection marker, (e) a third positive selection marker, and (f) a second site-specific recombination site, wherein the first positive selection marker, the second positive marker and the third positive selection marker are different from each other, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions involve three different, patentably distinct, nucleic acid constructs each with a unique arrangement of elements. A search of one would not be co-extensive with a search of the others because each invention comprises a unique sequential arrangement of positive and/or negative selection markers, site specific recombination sites, promoters, etc. A search of all three groups would therefore be burdensome.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, Ph.D., can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 2, 2008

/David Guzo/
Primary Examiner
Art Unit 1636